

REMARKS

I. Introduction

In response to the Office Action dated April 5, 2006, claims 1, 12, 25, 38, 51, 64, and 77 have been amended. Claims 1-11, 25-37, 51-63, 77-89 are withdrawn from consideration, and claims 12-24, 38-50, 64-76 remain pending under consideration. Entry of these amendments, and re-consideration of the application, as amended, is requested.

II. Claim Amendments

Applicants' attorney has made amendments to the claims as indicated above. These amendments were made solely for the purpose of clarifying the language of the claims, and were not required for patentability or to distinguish the claims over the prior art.

III. Restriction Requirement

The Restriction Requirement asserts that the three claim groups are distinct because they are directed to a self-expanding data package, generating data in a self-expanding data package, and utilizing data in a self-expanding data package.

Applicants set forth various arguments (see details below) traversing the restriction requirement. In response, the Office Action made the restriction requirement final and indicated that further arguments would not be considered. Applicants reassert the previously submitted arguments as set forth herein and respectfully request withdrawal of the restriction requirement.

Applicants assert that restriction is improper and therefore traverse the requirement. Applicants note that claim 1 provides for a self-expanding data package containing a set of constant lists, row validation calculations, and expanding the package using such constant lists and calculations. Similarly, claim 12 provides for generating the self-expanding data package by stating what is in the data package - namely, the set of constant lists, the calculations and the ability to expand the data package. In this regard, claim 12 provides for generating the various values in the set of constant lists and generating the calculations. Further, claim 12 provides for expanding the package using the constant lists and calculations. Similar to both claims 1 and 12, claim 25 provides for utilizing data in the self-expanding data package by receiving the package containing values in a

set of constant lists and calculations. Further, claim 25 provides for expanding the package using the constant list and calculations.

Thus, all of the independent claims relate to and provide very similar limitations. Even more specifically, Applicants submit that claim 12 is the process/method for making the product/table of claim 1. Accordingly, under MPEP 821.04, Applicants are entitled to rejoinder. Further, claim 25 has nearly identical limitations and would clearly not require any further search and/or consideration. In addition, the inventions are clearly related in their operation and effect and are therefore not distinct under MPEP 802.01.

In this regard, Applicants urge the Examiner take into consideration that the subject matter of each of the claim Groups is linked by a common inventive concept. According to M.P.E.P. §821.04 and 03, there are two criteria for a proper restriction requirement. First, the two inventions must be independent and distinct. In addition, there must be a serious burden on the Examiner if restriction is not required. Even if the first criterion has been met in the present case, which it has not, the second criterion has not been met.

In view of the above, Applicants respectfully request rejoinder of the non-elected claims.

IV. Non-Art Rejections

In paragraphs (5)-(6) of the Office Action, claims 64-76 were rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Applicants have amended claim 64 to overcome this rejection and submit that the rejection is now moot.

V. Prior Art Rejections

In paragraphs (10)-(11) of the Office Action, claims 12, 16, 18-21, 23, 34, 38, 42, 44-47, 49, 50, 64, 68, 70-73, 75 and 76 were rejected under 35 U.S.C. §102 as being anticipated by Hind et al., U.S. Patent 6,635,088 (Hind). In paragraphs (12)-(14) of the Office Action, claims 14, 15, 40, 41, 66 and 67 were rejected under 35 U.S.C. §103(a) as being obvious in view of the combination of Hind and Sasaki et al., U.S. Patent 6,434,623 (Sasaki). However, in paragraphs (15)-(16) of the Office

Action, claims 13, 39 and 65 were indicated as being allowable if rewritten in independent form to include the base claim and any intervening claims.

The independent claims were rejected as follows:

As to claim 12, Hind et al. teaches a method for generating data in a self-expanding data package in a computer system comprising:

generating one or more values in a set of one or more constant lists and storing said one or more values in the self-expanding data package (see column 7, lines 38-67);

generating one or more calculations that operate on one or more values in the set of one or more constant lists and storing said one or more calculations in the self-expanding data package (see column 8, line 44 through column 9, line 40);

transmitting the self-expanding data package to a second computer system that expands the self-expanding data package into an expanded table having expanded table rows (see column 8, lines 25-29 and see column 9, lines 30-41), wherein each expanded table row comprises a combination and each combination is generated by combining every value in each constant list with any combination of values from remaining parameters and performing the one or more calculations on the one or more values (see column 8, lines 30-41), wherein each expanded table row comprises a combination and each combination is generated by combining every value in each constant list with any combination of values from remaining parameters and performing the one or more calculations on the one or more values (see column 8, line 60 through column 9, line 29), wherein the one or more calculations eliminate one or more expanded table rows (see column 8, lines 44-59, where the entities are removed when the file is decompressed).

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As to claim 38, Hind et al. teaches an apparatus for generating data in a self-expanding data package in a computer system comprising:

(a) a computer system having a memory and a data storage device coupled thereto (see figure 1);

(b) one or more computer programs, performed by the computer system, for generating a self-expanding data package and storing the self-expanding data package in the memory (see column 8, line 44 through column 9, line 40), wherein the self-expanding data package comprising:

(i) one or more values in a set of one or more constant lists (see column 7, lines 38-67); and

(ii) one or more calculations that operate on one or more values in the set of one or more constant lists (see column 8, line 44 through column 9, line 40);

wherein the self-expanding data package is transmitted to a second computer system that expands the self-expanding data package into an expanded table having expanded table rows (see column 8, lines 25-59 and see column 9, lines 30-41), wherein each expanded table row comprises a combination and each combination is generated by combining every value in each constant list with any combination of values from remaining parameters and performing the one or more calculations on the one or more values (see column 8, line 60 through column 9, line 29), wherein the one or more calculations eliminate one or more expanded table rows (see column 8, lines 44-59).

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As to claim 64, Hind et al. teaches an article of manufacture comprising a program storage medium readable by a computer and embodying one or more instructions executable by the computer to perform a method of generating data in a self-expanding data package in a computer system, the method comprising:

generating, in the self-expanding data package, one or more values in a set of one or more constant lists (see column 7, lines 38-67);

generating, in the self-expanding data package, one or more calculations that operate on one or more values in the set of one or more constant lists (see column 8, line 44 through column 9, line 40P;

wherein the self-expanding data package is transmitted to a second computer system that expands the self-expanding data package into an expanded table having expanded table rows (see column 8, lines 25-59 and see column 9, lines 30-41), wherein each expanded table row comprises a combination and each combination is generated by combining every value in each constant list with any combination of values from remaining parameters and performing the one or more calculations on the one or more values (see column 8, line 60 through column 9, line 29), wherein the one or more calculations eliminate one or more expanded table rows (see column 8, lines 44-59).

Applicants traverse the above rejections for one or more of the following reasons:

- (1) Hind fails to teach, disclose or suggest a single package that contains both a set of constant lists and calculations that are performed on combinations of the constant lists;
- (2) Hind fails to teach, disclose or suggest such calculations that eliminate rows/combinations of such constant lists;
- (3) Hind fails to teach, disclose or suggest a table;
- (3) The Official Notice is without merit and improper.

Independent claims 12, 38, and 64 are generally directed to the generation of a self-expanding data package for product data. Specifically, values in a set of constant lists are generated and stored in the data package. In addition, calculations (that operate on the values) are generated and stored in the data package. Once the values and calculations are stored in the data package, the data package is transmitted to a second computer system that expands the data package. The claim limitations provide that the package is expanded into a table having rows. In addition, the expansion is performed by combining each value with other parameters (i.e., in the data package) and performing the calculations (from the data package) on the values. As amended, each expanded row of the table represents a product and comprises one of the combinations. Further, as amended, the calculations eliminate one or more rows from the table. Accordingly, all of the information for expanding the data package is contained within the data package itself. In other words, the values for the set of constant lists and the calculations performed on the values are both generated and then stored in the data package.

In addition, Applicants note that the amended claims explicitly provide for and recite product data and that each row represents a product. Accordingly, the invention is specific to product data. The invention solves a specific problem with publishing and consuming product data

by packaging up all part properties for a related family of parts in a compact form, with a mechanism defined for assembling the individual properties into normalized tables. The invention affects both the publishers and consumers of this part data in a way that they must understand. It is not a hidden algorithm that takes any generic XML file and makes it smaller (e.g., as in Hind).

In addition, Applicants note that Hind is merely a mechanism to compress XML and related files using a string substitution mechanism. Such a solution bears no relationship to the kind of data being stored, or the processing of that data. It is a generic compression mechanism based on repeating strings in XML and related structured text files. (See Abstract).

In rejecting the claims, the Office Action first asserts that col. 7, lines 38-67 teaches the generation of values in a constant list and storing of the values in the self expanding data package. Col. 7, lines 38-67 provides:

In the preferred embodiment, the present invention is implemented as one or more computer software programs. The implementation of the software that compresses XML and/or DTD files may operate on a server in a network, as one or more modules (also referred to as code subroutines, or "objects" in object-oriented programming) which are invoked upon request. Alternatively, the compression software may operate on a user's workstation. The logic implementing this file compression may be integrated with the code of a program which creates the XML or DTD files, or it may be implemented as one or more separate utility modules, which provide compression that is performed after the XML or DTD file has been created, without deviating from the inventive concepts disclosed herein. Similarly, the file decompression software (where applicable, as discussed in detail below) may operate on a server, or on a user's workstation, and this software may be provided in one or more separate utility modules that are invoked to decompress the file content before using it in an application, or it may be integrated into an application that processes the files. The server may be functioning as a Web server, where that Web server provides services in response to requests from a client connected through the Internet. Alternatively, the server may be in a corporate intranet or extranet of which the client's workstation is a component, or in any other network environment. While the preferred embodiment anticipates that the compressed files are sent over a network connection, the file content may also be transferred between computers via a storage media (such as diskette), without deviating from the inventive concepts disclosed herein.

As can be seen from this text, there is not even a remote reference to constant lists or a self-expanding data package for product data as claimed.

Similarly, to teach the generation of calculations that operate on values in the constant lists and the storage of the calculations in the self expanding data package, the Office Action relies on col. 8, lines 44 through col. 9, line 40. This portion of text merely describes the ability to substitute text using an entity declaration. However, once again, there is no constant list, nor is there a calculation that operates on values in such a constant list.

The Office Action then proceeds to assert that the claimed table that is generated from the self-expanding data package with rows is taught by Hind Col. 8, lines 25-59 and col. 9, lines 30-41. Applicants respectfully disagree with and traverse such an assertion. Firstly, such text does not even reference, suggest, or allude to a table in any way shape or form. In addition, the claims are specific in the limitations and description of the table. Namely, the claims provide that the table has expanded table rows, with each row representing a product, and each row is a combination that is generated by combining every value in each constant list with any combination of values from remaining parameters and performing calculations on the values, wherein the calculations eliminate one or more table rows. Instead of discussing tables and table rows that are generated by combining various values and the elimination of rows, Hind merely describes the substitution of text. Such a teaching not only fails to teach or remotely suggest the invention, but is not even related or relevant to the present claims whatsoever. Again, the claims provide specific details relating to tables and table rows. Hind fails to reference or describe any such table, rows in a table, or the elimination of such rows, explicitly or implicitly. Without even suggesting the use of such a table and the claimed table row limitations, Hind cannot possibly teach, anticipate, or render the present invention obvious.

In addition, Applicants note that dependent claims 17, 43, and 69 provide that the self-expanding data package comprises product data for use in a CAD design application. In rejecting these claims, the Examiner took official notice that it would have been obvious to modify Hind to include the self-expanding data package comprises product data for use in a CAD application because it would allow information from one engineer using a CAD program to be transmitted to another engineer using a CAD program in an efficient manner.

Applicants appreciate the acknowledgement of the benefits of the present invention. However, not only is there a complete failure in Hind to even remotely suggest such product data (which is not claimed in the independent claims), but there is no suggestion to extend Hind into such an area and it would not be obvious for an engineer to utilize the method of the invention to transport product data as claimed. In this regard, the Examiner takes Official Notice of the obviousness of the invention without any foundation or support in the prior art whatsoever. Applicants note that it is improper to take Official Notice of the obviousness of the invention.

Instead, Official Notice is only proper for a fact. In this regard, the present Office Action fails to take Official Notice of any such fact.

Further, under MPEP 2144.03, there must be some form of evidence in the record to support an assertion of common knowledge. See *Lee*, 277 F.3d at 1344-45, 61 USPQ2d at 1434-35 (Fed. Cir. 2002); *Zurko*, 258 F.3d at 1386, 59 USPQ2d at 1697. There is no form of such evidence in the present record.

In addition, , in accordance with MPEP 2144.03(C), Applicants challenge the Official Notice and any factual assertion contained therein as not properly officially noticed or not properly based upon common knowledge. In this regard, under MPEP 2144.03(C), the Examiner must support the finding/Office Notice with adequate documentary evidence. Thus, the examiner must provide documentary evidence in the next Office action if the rejection is to be maintained. See 37 CFR **1.104(c)(2)**. See also *Zurko*, 258 F.3d at 1386, 59 USPQ2d at 1697 ("[T]he Board [or examiner] must point to some concrete evidence in the record in support of these findings" to satisfy the substantial evidence test).

Further, Sasaki fails to cure the deficiencies of Hind. Moreover, the various elements of Applicants' claimed invention together provide operational advantages over Hind and Sasaki. In addition, Applicants' invention solves problems not recognized by Hind and Sasaki.

Thus, Applicants submit that independent claims 12, 38 and 64 are allowable over Hind and Sasaki. Further, dependent claims 13-24, 39-50 and 65-76 are submitted to be allowable over Hind and Sasaki in the same manner, because they are dependent on independent claims 12, 38 and 64, respectively, and thus contain all the limitations of the independent claims. In addition, dependent claims 13-24, 39-50 and 65-76 recite additional novel elements not shown by Hind and Sasaki.

VI. Conclusion

In view of the above, it is submitted that this application is now in good order for allowance and such allowance is respectfully solicited. Should the Examiner believe minor matters still remain that can be resolved in a telephone interview, the Examiner is urged to call Applicants' undersigned attorney.

Respectfully submitted,

GATES & COOPER LLP
Attorneys for Applicant(s)

Howard Hughes Center
6701 Center Drive West, Suite 1050
Los Angeles, California 90045
(310) 641-8797

Date: June 29, 2006

By: /Jason S. Feldmar/
Name: Jason S. Feldmar
Reg. No.: 39,187

JSF/kmk

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